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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re AICAD S.n.c. of Luca PEDROTTI & C.

Serial No. 75/320,218

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P.L.L.C. for AICAD S.n.c. of Luca PEDROTTI & C.

Terria P. Hicks, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney)

Before Hanak, Walters and Rogers, Administrative Trademark
Judges.

Opinion by Rogers, Administrative Trademark Judge:

AICAD S.n.c. of Luca PEDROTTI & C. [Aicad] has filed
an application to register LIZARD AICAD as a trademark in
International Class 25 for goods identified by amendment as
"Footwear, namely sandals and moccasins, not made of
reptile skin and not simulating reptile skin; T-shirts."¹

¹ Serial No. 75/320,218, filed July 7, 1997, based on applicant's
allegation of a bona fide intention to use the mark in commerce.

The Trademark Examining Attorney has made final a refusal of registration on two grounds: that applicant's mark is deceptively misdescriptive of the composition or a feature of applicant's footwear², and thereby barred from registration by Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and that applicant's mark is deceptive, and thereby barred from registration by Section 2(a) of the Act, 15 U.S.C. §1052(a). Applicant has appealed both grounds for refusal. Briefs were filed; and the applicant filed but subsequently withdrew a request for an oral hearing.³

The test for determining whether a mark is deceptively misdescriptive under Section 2(e)(1) requires us to determine (1) whether the matter sought to be registered misdescribes the goods and, if so, (2) whether any

² The Examining Attorney has expressly not refused registration of applicant's mark as used for "T-shirts". However, applicant did not request division of its application prior to filing its appeal.

³ The Examining Attorney has not raised any question about the registrability of the AICAD portion of applicant's mark and accepts it as "a coined, fanciful term with no meaning." Rather, the Examining Attorney argues that LIZARD is the dominant term in the mark and, thus the mark as a whole is unregistrable. Applicant admits that LIZARD is misdescriptive of applicant's goods but, noting that it is only one term in a composite mark, denies that the mark as a whole is misdescriptive. The question whether the deceptive misdescriptiveness refusal could be overcome with a disclaimer of LIZARD has not been raised by either applicant or the Examining Attorney and, therefore, is not before us. Moreover, a disclaimer would not obviate the

prospective purchaser is likely to believe the misdescription. In re Quady Winery Inc., 221 USPQ 1213, 1214 (TTAB 1984).

The test for determining whether a mark is deceptive under Section 2(a) restates the two-part *Quady* test and adds a third prong: If the term is misdescriptive and prospective purchasers are likely to believe that the misdescription actually describes the goods, is the misdescription likely to affect the decision to purchase? See In re Budge Manufacturing Co., Inc., 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988).

Applicant concedes that LIZARD is misdescriptive of applicant's footwear, so the first prong of the *Quady* and *Budge* tests is met. Applicant and the Examining Attorney disagree, however, on the second prong of the *Quady* and *Budge* tests, i.e., whether consumers would believe the misdescription.

In support of her refusal of registration, the Examining Attorney has made of record the following evidence: dictionary definitions for "lizard," one of which is "[l]eather made from the skin of a lizard" and another which is "leather made from the skin of the lizard,

deceptiveness refusal. American Speech-Language-Hearing Ass'n v. National Hearing Aid Soc., 224 USPQ 798 (TTAB 1984).

used for shoes, purses, etc."; dictionary definitions for the terms "sandal" and "moccasin"; excerpts from Modern Footwear Materials & Processes A Topical Guide to Footwear Technology by Walter E. Cohn [© 1969; hereinafter *Guide to Footwear*]; five excerpts retrieved from the NEXIS database of periodicals; and two references retrieved from three searches of the Internet. The applicant, in its response to the initial refusal of registration, filed copies of a brochure illustrating the general nature of its goods although not showing any goods identified by the mark in the involved application.⁴

The Examining Attorney argues that this evidence satisfies the second prong of the *Quady* and *Budge* tests because it establishes (1) that lizard skin is a highly desirable material for shoes, including sandals and moccasins, and (2) that purchasers "are accustomed to seeing 'lizard' associated with the making of shoes."

In reply, applicant states "[t]hese are not points of contention between the Applicant and the Examining Attorney." While this may appear to be a concession that the Examining Attorney has met the second prong of the

⁴ We note that the brochure shows use of the term LIZARD alone and with the ® statutory registration symbol appended thereto. The statutory registration symbol used to show registration of a mark in the United States may be used only after a registration has issued, and even then, only for the mark actually registered.

Quady and *Budge* tests, the applicant goes on to state that, in view of the limitation in the identification of goods, "[t]he point of contention... is whether it is likely that a potential purchaser of Applicant's sandals and moccasins would believe that they were actually made of lizard skin." Thus, it is clear that the applicant believes the Examining Attorney has not met the second prong of the *Quady* and *Budge* tests.

Applicant argues that its goods, as illustrated by the brochures it has made of record, are "rugged sporting type sandals and moccasins" for outdoor activities and would not commonly be thought of by consumers of such goods as likely to be made of reptile or lizard skin. However, applicant's identification of goods is not limited to sporting-type sandals and moccasins. Moreover, this application is based on intent-to-use the mark in commerce and applicant has not filed an amendment to allege use. The brochures are of limited probative value because they show use of LIZARD but do not show use of the mark LIZARD AICAD. Thus, the brochures are not evidence that applicant's mark LIZARD AICAD is used for the sporting-type sandals and moccasins illustrated therein. We have considered, as we must, applicant's goods to include all types of sandals and moccasins, e.g., those for rugged outdoor activities, those

for leisure wear, and those for high fashion wear, among others.

We turn our consideration to the evidence submitted by the Examining Attorney in support of her burden of proof. The dictionary definitions and references from the *Guide to Footwear* indicate that leather made from lizard skin may be used for shoes. This, alone, does not establish that the public would be aware of the materials from which their footwear is made or would believe that applicant's footwear is made of lizard skin.

The five NEXIS references range from 1985-1996. There is one NEXIS reference for "lizard moccasins", and four references for "lizard sandals." However, these references are few in number and years passed between each of them. An occasional reference in a mass-market periodical every few years does not establish that purchasers of sandals and moccasins would be aware of the materials from which their footwear is made, or that footwear may be made from lizard skin.

In her brief, the Examining Attorney argues that "The search results from the [Internet] YAHOO! and ALTA VISTA search engines demonstrate over twenty (20) websites for

lizard sandals and shoes."⁵ However, we find only one such reference which shows a grainy photograph of shoes and an printout that lists the following: "Exotic Boots Ltd.- western boots from the traditional styles to the more exotic ostriich [sic], snake skin, shark, crocodile, lizard and alligartor [sic]."

The dictionary definitions, together with the NEXIS references and Internet print-outs, do not establish whether the public is aware that footwear may be made from lizard skin, and, thus, whether they would believe that applicant's footwear is made from lizard skin. This evidence certainly does not allow us to conclude, as the Examining Attorney argues, that consumers of sandals and moccasins are "accustomed" to finding sandals and moccasins made of lizard skin in the marketplace.

Applicant states that lizard skin products have "a distinctive mottled appearance." As identified, applicant's footwear is not made of reptile skin, nor does it simulate reptile skin.⁶ Any purchaser of moccasins or

⁵ A mere list of website "hits" returned when a search of the Internet is performed for certain terms is of little, if any, value. It is the printouts of the websites themselves that may have probative value.

⁶ Reptile, by dictionary definition, includes "turtles, lizards, snakes, crocodilians, and the tuatara." 1121 *The Random House College Dictionary* (Revised Ed. 1982).

sandals who is familiar with the actual appearance of lizard skin would not be likely to believe that applicant's goods are made of lizard skin, because such a purchaser presumably would recognize its appearance and, thus, not believe mistakenly that footwear not simulating lizard skin was, in fact, lizard skin.

Moreover, as stated above, there is insufficient evidence in the record to establish that the public is aware that footwear may be made from lizard skin and whether the public would believe that applicant's footwear is made from lizard skin regardless of its appearance. Thus, there is insufficient evidence for us to conclude that a prospective purchaser of sandals or moccasins, not familiar with the use of lizard skin as a footwear material, would, when encountering applicant's goods, mistakenly believe that they were made of such material.

We are not convinced otherwise by the Examining Attorney's hypothetical argument that a consumer might very well conclude that applicant had used lizard skin in the manufacture of its goods but had treated it in such a manner as to vitiate the normal appearance of the skin. Implicit in this argument is the Examining Attorney's assumption that any consumer would know what lizard skin looked like and, when confronted with applicant's footwear

not made of or simulating lizard skin, would conclude that the goods are lizard skin and that applicant had treated the lizard skin so that it no longer looked like lizard skin. While the *Guide to Footwear* establishes that buffing or plating of leather can smooth its grain, the Examining Attorney has presented no evidence that such processes would be applied to lizard skin to such an extent that it would cease to be recognized as such. Moreover, we find the consumer thought process posited by the Examining Attorney to be both conjecture and unlikely. Based on the record before us, we agree with applicant's argument that it is more likely that consumers would view the term LIZARD as suggestive of the grip that users would experience when wearing applicant's sandals and moccasins.

The Examining Attorney correctly states that "the mark standing alone" must not be deceptively misdescriptive or deceptive, and that a disclaimer or limitation on labelling or in the identification of goods cannot alone remove a mark from being deceptively misdescriptive or deceptive. See *Budge*, *supra*, 8 USPQ2d at 1261. However, this case differs from the *Budge* case in that the Examining Attorney has not established the second prong of the test, namely, that prospective purchasers would be likely to believe the misdescription.

This case also differs from the case cited by the Examining Attorney, In re Woodward & Lothrop Inc., 4 USPQ2d 1412 (TTAB 1987). In that case, the Board concluded that a disclaimer in the identification of goods regarding the nature of the material composition of the goods was insufficient because the record in that case established that prospective purchasers would believe that "cameo" describes the composition of the goods and that sales of the product could occur without giving prospective purchasers an opportunity to view the goods. *Id.* at 1414. In this case, the evidence does not establish that prospective purchasers of applicant's goods would mistakenly believe that goods are made of lizard skin.

In conclusion, the Examining Attorney has not satisfied the second prong of the *Quady* and *Budge* tests and each of the grounds for refusal fail. It is unnecessary for us to consider the third prong of the test for the issue of deceptiveness.

We acknowledge that, in an inter partes context, competitors of applicant might be able to build a different record which would support a refusal of registration. The record presented by the Examining Attorney, however, falls short.

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Decision: The refusals on the ground that applicant's mark is deceptively misdescriptive and on the ground that applicant's mark is deceptive both are reversed.

E. W. Hanak

C. E. Walters

G. F. Rogers

Administrative Trademark
Judges, Trademark Trial
and Appeal Board